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EXAMINER
DAILEY, THOMAS J

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *24 October 2008*.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-28,45-51 and 60-69* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-28,45-51 and 60-69* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some *   c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date *10/24/2008; 12/02/2008*.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____ .

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since

this application is eligible for continued examination under 37 CFR 1.114, and the

fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous

Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's

submission filed on October 24, 2008 has been entered.

2. Claims 68-69 were added by the amendment filed on October 24, 2008.

3. Claims 1-28, 45-51, and 60-69 are pending.

Response to Arguments

4. The U.S.C. 112 second paragraph rejections directed at claims 1-28, 45-51, and

60-67 are withdrawn in light of the applicant's entered amendment.

5. Applicant's arguments with respect to the prior art rejection of the claims have

been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set
forth in section 102 of this title, if the differences between the subject matter sought to be patented and
the prior art are such that the subject matter as a whole would have been obvious at the time the
invention was made to a person having ordinary skill in the art to which said subject matter pertains.
Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 1, 3-9, 11-15, 17-23, 25-28, 45-51, 60-61, 63-65, and 67-68 are rejected
    under 35 U.S.C. 103(a) as being unpatentable over Heiner (US Pat. 6,112,227,
    cited on IDS dated 8/23/2004) and Kirsch (US Pat. 6,546,416), in further view of
    applicant's admitted prior art (hereafter AAPA, with citations under this heading
    being taken from the applicant's own specification) and Espinosa et al (US Pub.
    2007/0204043), hereafter "Espinosa."

8. As to claim 1, Heiner discloses a method for modifying mail filters associated with
    a user of a mail system, the method comprising:

    generating a petition by a sender based on user information, the petition
    comprising a request for the sender to be added to a list of approved mail
    senders, the list associated with the user (column 3, lines 56-62, source client
    sends a reply (petition) to register and become a valid sender);

    transmitting the petition from the sender to a recipient as a result an email
    request and storing said petition at the recipient, wherein the petition is
    transmitted before sending electronic mail between the sender and the recipient
    (column 3, lines 56-62; petition sent from source client to destination SMTP
    server (i.e. where the recipient resides));

    receiving a login request from the user to the mail system (column 3, lines 39-
    48, as there is a destination SMTP server, the recipient will inherently login to
    retrieve emails);

checking for the petition in the computing device where said recipient resides (column 3, lines 56-62); and

processing said the petition if the token is found in the recipient and modifying the mail filters associated with the user by adding the sender to the list of approved mail senders as specified in the petition (column 3, lines 56-62);

transmitting an electronic mail message from the sender to the recipient and allowing the recipient to receive the electronic mail message from the sender as specified in the petition (column 4, lines 20-26).

But, Heiner does not explicitly disclose a token containing the petition. Rather, Heiner discloses the petition is composed of a response to a destination client and each destination client is allowed to compose their own questions or instructions required to submit a valid petition (column 3, lines 56-67).

However, Kirsch discloses generating and transmitting a digital signature containing a valid petition to add a sender to an approved sender list (column 3, lines 43-57, a digital signature (token) is transmitted to verify a sender).

As Heiner discloses each destination client is allowed to compose their own questions or instructions that, when followed, creates a valid petition and Kirsch discloses a digital signature constituting a valid petition, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine

the teachings of Heiner and Kirsch thus improving the means for verifying

senders.

Further, neither Heiner nor Kirsch disclose receiving a subscription request

from a recipient to a sender, the subscription request including user information,

wherein the subscription request is received as part of a web browser interaction

before sending electronic mail between the sender and the recipient and wherein

the subscription request is initiated by the recipient; and the petition is

transmitted during said web browser interaction before sending electronic mail

between the sender and the recipient.

However, AAPA discloses receiving a subscription request from a recipient to

a sender, the subscription request including user information, wherein the

subscription request is received as part of a web browser interaction before

sending electronic mail between the sender and the recipient and wherein the

subscription request is initiated by the recipient (page 1, [0005], email addresses

are commonly provided (subscription request which would precede emails from

that sender) by customers (recipients) when interacting with a company's

(senders) website (i.e. via a web browser)) and Espinosa discloses a petition to

by a sender based on user information comprising a request for the sender to be

added to a list of approved mail senders, wherein the petition is transmitted

during a web browser interaction before sending electronic mail between the

sender and the recipient ([0015], email is prevented from being delivered; sender

is instructed to access internet page (i.e. via a web browser) and file out the web

page so as to receive access code which allows sender to be added to approved

senders list).

Therefore it would have been obvious to one of ordinary skill in the art at the

time of the invention to combine the teachings of Kirsch and Heiner with that of

the applicant's admitted prior art and Espinosa via simple substitution of known

methods (i.e. subscribing to emails via a web browser and petitioning via a web

browser) to achieve the predictable result of adding legitimate mail senders to a

recipient's white or approved senders list.

9. As to claim 7, Heiner discloses a method for modifying mail filters associated with

a user of a mail system, the method comprising:

generating a petition by the sender based on the user information, the petition

comprising a request for the sender to be added to a list of approved mail

senders, the list associated with the user (column 3, lines 56-62, source client

sends a reply (petition) to register and become a valid sender);

transmitting petition from the sender to a recipient a reference to a location of

the as a result of the subscription request and storing said petition at a computing

device where the recipient resides, wherein the petition is transmitted before

sending electronic mail between the sender and the recipient (column 3, lines 56-62; petition sent from source client to destination SMTP server (i.e. where the recipient resides));

receiving a login request from the user to the mail system (column 3, lines 39-48, as there is a destination SMTP server, the recipient will inherently login to retrieve emails);

searching in the computing device where the recipient rides for the reference to a location of the petition (column 3, lines 56-62); and

retrieving said the petition from said location if the token is found in on the computing device where the recipient resides and modifying the mail filters associated with the user by adding the sender to the list of approved mail senders as specified in the petition (column 3, lines 56-62);

transmitting an electronic mail message from the sender to the recipient and allowing the recipient to receive the electronic mail message from the sender as specified in the petition (column 4, lines 20-26).

But, Heiner does not explicitly disclose a token containing the petition. Rather, Heiner discloses the petition is composed of a response to a destination client and each destination client is allowed to compose their own questions or instructions required to submit a valid petition (column 3, lines 56-67).

However, Kirsch discloses generating and transmitting a digital signature containing a valid petition to add a sender to an approved sender list (column 3, lines 43-57, a digital signature (token) is transmitted to verify a sender).

As Heiner discloses each destination client is allowed to compose their own questions or instructions that, when followed, creates a valid petition and Kirsch discloses a digital signature constituting a valid petition, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Heiner and Kirsch thus improving the means for verifying senders.

Further, neither Heiner nor Kirsch disclose receiving a subscription request from a recipient to a sender, the subscription request including user information, wherein the subscription request is received as part of a web browser interaction before sending electronic mail between the sender and the recipient and wherein the subscription request is initiated by the recipient; and the petition is transmitted during said web browser interaction before sending electronic mail between the sender and the recipient.

However, AAPA discloses receiving a subscription request from a recipient to a sender, the subscription request including user information, wherein the subscription request is received as part of a web browser interaction before

sending electronic mail between the sender and the recipient and wherein the subscription request is initiated by the recipient (page 1, [0005], email addresses are commonly provided (subscription request which would precede emails from that sender) by customers (recipients) when interacting with a company's (senders) website (i.e. via a web browser)) and Espinosa discloses a petition to by a sender based on user information comprising a request for the sender to be added to a list of approved mail senders, wherein the petition is transmitted during a web browser interaction before sending electronic mail between the sender and the recipient ([0015], email is prevented from being delivered; sender is instructed to access internet page (i.e. via a web browser) and file out the web page so as to receive access code which allows sender to be added to approved senders list).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Kirsch and Heiner with that of the applicant's admitted prior art and Espinosa via simple substitution of known methods (i.e. subscribing to emails via a web browser and petitioning via a web browser) to achieve the predictable result of adding legitimate mail senders to a recipient's white or approved senders list.

10. As to claims 15 and 45, they are rejected by the same rationale set forth in claim 1's rejection.

11. As to claim 21, it is rejected by the same rationale set forth in claim 7's rejection.

12. As to claims 3, 11, 17, and 25, Kirsch discloses the petition specifies an identification method that will be used to verify that an email message is from a given sender (column 3, lines 43-57).

13. As to claims 4, 12, 18, and 26, Kirsch discloses the identification method utilizes an origin electronic mail address for the sender (column 3, lines 43-57).

14. As to claims 5, 13, 19, and 27, Kirsch discloses the identification method utilizes a digital signature (column 3, lines 43-57).

15. As to claims 6, 14, 20, 28, and 51, Kirsch discloses the user information comprises a user identifier (column 3, lines 43-57).

16. As to claims 8 and 22, Kirsch discloses receiving a request for the petition from a party maintaining the list of approved mail senders and transmitting the petition in response to the request for the petition (column 3, lines 58-67, computer sends challenge email soliciting a petition to be added to verified source address list).

17. As to claim 9 and 23, Kirsch discloses including authentication credentials in the token and receiving authentication credentials with the request for the petition (column 3, lines 58-67).

18. As to claim 46, Kirsch discloses the token includes the petition (column 3, lines 58-67, challenge reply includes petition information (i.e. the data necessary to add the sender to the verified source address list).

19. As to claim 47, Kirsch discloses the token includes a reference to a petition location (column 7, lines 22-35, a challenge reply (email containing the petition) is received and evaluated, inherently a reference to the location of the petition is given as the challenge reply is actively evaluated).

20. As to claim 48, Kirsch discloses the petition specifies an identification method that will be used to verify that an email message is from a given sender (column 3, lines 43-57).

21. As to claim 49, Kirsch discloses the identification method utilizes a sender mail address (column 3, lines 43-57).

22. As to claim 50, Kirsch discloses the identification method utilizes a digital signature (column 3, lines 43-57).

23. As to claims 60 and 64, Kirsch discloses requesting a confirmation of the success of the petition by the sender; and transmitting a confirmation of the petition from the recipient to the sender indicating success or denial of the petition (column 10, lines 25-38).

24. As to claims 61 and 65, Kirsch discloses the sender assumes that the petition was denied by the recipient if confirmation was requested by the sender but never received from the recipient (column 3, 45-57)

25. As to claims 63 and 67, Kirsch discloses maintaining a petition rules list that specify special handling of the petition based on the data contained in the petition such that the petition rule list identifies recipients whose petition processors are located on the systems of a remote mail provider (column 3, lines 43-57).

26. As to claim 68, Espinosa discloses the petition is transmitted to the recipient's web browser and wherein the recipient's web browser provides it to a petition processor ([0015]).

27. Claims 2, 10, 16, 24, 62, 66, and 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heiner, Kirsch, Espinosa, and AAPA, as applied to claims 1, 7, 15, and 21, in view of what is well known in the art.

28. As to claims 2, 10, 16, and 24, Heiner, Kirsch, Espinosa, and AAPA do not explicitly disclose the token is a cookie. However, Official Notice (see MPEP 2144.03 Reliance on "Well Known" Prior Art) is taken one of ordinary skill in the art at the time of the invention would view it as an obvious modification of Heiner, Kirsch, Espinosa, and AAPA teachings to utilize a cookie to store the petition to the user, as a cookie is a common means to organize data in the art.

29. As to claims 62 and 66, Heiner, Kirsch, Espinosa, and AAPA fail to disclose the token containing the petition is transmitted from the sender to the recipient via hypertext transfer protocol (HTTP). However, Official Notice (see MPEP 2144.03 Reliance on "Well Known" Prior Art) is taken one of ordinary skill in the art at the time of the invention would view it as an obvious modification of Heiner, Kirsch, Espinosa, and AAPA teachings to utilize known protocol to generate and store a digital signature as a HTTP is a widely used protocol in emails and the Internet in general.

30. As to claims 69, Heiner, Kirsch, Espinosa, and AAPA fail to disclose the petition processor is configured as a web browser plug-in. However, Official Notice (see

MPEP 2144.03 Reliance on "Well Known" Prior Art) is taken one of ordinary skill

in the art at the time of the invention would view it as an obvious modification of

Heiner, Kirsch, Espinosa, and AAPA teachings to utilize known practice in web

page design (i.e. the use of plug-in in a web page) in order to simply the

programming of the web page and provide a means for a user to interact with a

web page.

Conclusion

31. Any inquiry concerning this communication or earlier communications from the

    examiner should be directed to Thomas J. Dailey whose telephone number is

    571-270-1246. The examiner can normally be reached on Monday thru Friday;

    9:00am - 5:00pm.

32. If attempts to reach the examiner by telephone are unsuccessful, the examiner's

    supervisor, John Follansbee can be reached on 571-272-3964. The fax phone

    number for the organization where this application or proceeding is assigned is

    571-273-8300.

33. Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR

only. For more information about the PAIR system, see http://pair-

direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-

free). If you would like assistance from a USPTO Customer Service

Representative or access to the automated information system, call 800-786-

9199 (IN USA OR CANADA) or 571-272-1000.

/T. J. D./
Examiner, Art Unit 2452

/Kenny S Lin/

Primary Examiner, Art Unit 2452